

In re PULLELA ET AL., Application No. 10/625,063
Amendment B

REMARKS

The final Office action dated February 22, 2006, and the references cited have been fully considered. In response, please enter the enclosed Request for Continued Examination (RCE) and the following amendments, and consider the following remarks. Reconsideration and/or further prosecution of the application is respectfully requested. No new matter is added herein.

Applicants have taken this opportunity to use already paid for claim fees to add new dependent claims 26-29 which recite a variant of processing the packet based on said generated masked flow identification value, with support provided at least by step 110 of FIG. 1A of the originally filed application. No new matter is added.

Applicants appreciate the thoughtful examination of the application, and for providing applicants a copy of the 1449 associated with the IDS properly filed via facsimile on 1-12-06.

Missing Page of Returned 1449 of eIDS. To clarify the record, Applicants request the Office return an initialed, signed and dated copy of the 1449 of the electronic Information Disclosure Statement, properly filed on January 12, 2006. The USPTO's Electronic File Wrapper and the mailed Office action include only page 2 of this 1449. Applicants request that an initialed, signed and dated copy of the entire 1449 of this eIDS be sent to Applicants.

Applicants further note that another eIDS is being filed on the same day as this paper.

§ 101 Issues. Applicants have elected to file cross-terminal disclaimers in both this application and in 10/625,012, to remove the § 101 issue in a financially cost-effective manner. Canceled claim 11, and pending claims 12-17 are rejected under § 101 as computer-readable media was not limited to tangible media for containing the instructions and/or data. Applicants have amended the specification and independent claim 12 to specify that the computer-readable medium tangibly embodies the instructions. For at least these reasons and that claim 11 was cancelled in a previous amendment, Applicants request the rejections be withdrawn.

In re PULLELA ET AL., Application No. 10/625,063
Amendment B

Rejections Based on Prior Art.

In regards to pending independent claims 2, 10, 12, and 20, Applicants again respectfully submit that the prior art of record neither teaches nor suggests all the recited limitations; and therefore, are allowable. Applicants respectfully request the withdrawal of all rejections based on prior art as all claims depend from one of these allowable independent form. As each of independent claims 2, 10, 12, and 20 recite similar elements/limitations, Applicants will address claim 1 with these remarks applicable to these other claims.

It is well-established law that the burden is on the Office to initially present a *prima facie* unpatentability (e.g., anticipation, obvious) rejection, before Applicant has any burden of proof of disproving any application of a cited reference against a claim. *In re Warner*, 379 F2d. 1011, 1016, 154 USPA 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986). The MPEP and law is clear that for anticipation, the reference *must teach each and every aspect of the claimed invention* either explicitly or impliedly, and the burden is on the Office to present a *prima facie* case of anticipation. MPEP § 706.02. Inherent means it *must* occur. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 (*emphasis in original*). Moreover, obviousness under 35 USC § 103(a) requires "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 706.02(j) (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)) (*emphasis added*). Applicants respectfully submit that for at least original claims 19-27, such an initial showing has not been done.

Claim 2 recites, *inter alia*, "masking the flow identification value with the flow identification value mask to generate a masked flow identification value," with the elements of the flow identification value with the flow identification value mask previously introduced in the claim (i.e., this previous introduction provides the antecedent basis for these elements). The Office action equates Ikeda et al.'s VPI/VCI indication as the recited limitation of "the flow

In re PULLELA ET AL., Application No. 10/625,063
Amendment B

identification value" and equates Ikeda et al.'s retrieval flag as the recited limitation of "the flow identification value mask." Therefore, a *prima facie* anticipation rejection would need to teach that Ikeda et al.'s VPI/VCI indication is masked with Ikeda et al.'s retrieval flag, which is not done. Moreover, even Ikeda et al.'s masking of the flow retrieval key 25 with retrieval flag 24 neither teaches nor suggest such a configuration, as it fails to mask Ikeda et al.'s VPI/VCI. In fact, the operation of Ikeda et al. operates much differently than recited in the claims as Ikeda et al.'s retrieval flag 24 is retrieved based on the VPI/VCI of an ATM cell; while Ikeda et al.'s flow retrieval key (25) is extracted from the header of an IP packet and not of the header of the ATM cell. For at least these reasons, the prior art of record neither teaches nor suggests all the recited claims elements/limitations of a pending claims, and therefore, Applicants respectfully request all the claim rejections be withdrawn. Also, as the Office action did not establish a proper *prima facie* rejection of any claim, Applicants have no burden to discuss any other claim limitation or claim.

Applicants will attempt to elaborate further. Below is a mapping of claim elements to corresponding element of Ikeda et al. as applied by the Office.

(a) (claim 1) a flow identification value <== (Ikeda et al.) VPI/VCI 21

(b) (claim 1) performing a lookup based on the flow identification value to identify a flow identification value mask <== (Ikeda et al.) VPI/VCI 21 indexes into Retrieval Flag Table 3 to generate retrieval flag 24

(c) (claim 1) masking the flow identification value with the flow identification value mask to generate a masked flow identification value <== (Ikeda et al.) Flow Retrieval Key 25 masked by Retrieval Key Mask Section 21 based on Retrieval Key 24.

In re PULLELA ET AL., Application No. 10/625,063
Amendment B

The Office inconsistently equates elements of Ikeda et al. to the recited limitation of the flow identification value. First, it equates VPI/VCI 21, then it equates Flow Retrieval Key 25. Therefore, it is not a proper rejection. To be coherent, FIG. 1 of Ikeda et al. would need to show the line representing VPI/VCI 21 going into both Retrieval Flag Table 3 and Retrieval Key Mask Section 4.

As the Office has applied Ikeda et al., it is *impossible* for Ikeda et al. to operate as recited in the claims, as VPI/VCI *is not supplied* to Retrieval Key Mask Section 21, therefore, it can't be masked as presented in the Office action. VPI/VCI is extracted from the ATM cell, while the Flow Retrieval Key is based on the header of the IP packet, which are completely different things. Applicants refer the Office to FIG. 5 of Ikeda et al. which illustrates this difference as it shows item 21 (VPI/VCI) is extracted *from the header of the received ATM cell*, while the Flow Retrieval Key 25 is extracted from the header of the IP Packet contained *Payload of the ATM cell*. Therefore, Ikeda et al. neither teaches all the limitations of any claim, and Applicants further submit that Ikeda's use of two different spaces (ATM/IP) teaches away from that recited in the claims.

For at least the reasons presented herein, all claims are patentably distinct from the prior art references cited in the Office action. If the Examiner complies with MPEP § 706 and 37 CFR 1.104(c)(2), then the Examiner cited the best prior art references available. As the prior art of record neither teaches nor suggests all the claim limitations of any pending claim, then all pending claims are believed to be allowable over the best prior art available, and Applicants request the claims be allowed and the application pass to issuance.

Final Remarks. Applicants hereby petitions/requests a one-month extension of time, with payment for such extension of time provided by the enclosed credit card payment form (PTO-2038). Should a different extension of time be deemed appropriate, Applicants hereby petition for such deemed extension of time. Applicants further authorize the charging of Deposit

In re PULLELA ET AL., Application No. 10/625,063
Amendment B

Account No. 501430 for any fees that may be due in connection with this paper (e.g., claim fees, extension of time fees).

In view of the above remarks and for at least the reasons presented herein, all pending claims are believed to be allowable over all prior art of record, the application is considered in good and proper form for allowance, and the Office is respectfully requested to issue a timely Notice of allowance in this case. Applicant requests any and all rejections and/or objections be withdrawn. If, in the opinion of the Office, a telephone conference would expedite the prosecution of the subject application, the Office is invited to call the undersigned attorney, as Applicants are open to discussing, considering, and resolving issues.

Respectfully submitted,
The Law Office of Kirk D. Williams

Date: June 22, 2006

By

 6-22-2006

Kirk D. Williams, Reg. No. 42,229
One of the Attorneys for Applicant
CUSTOMER NUMBER 26327
The Law Office of Kirk D. Williams
1234 S. OGDEN ST., Denver, CO 80210
303-282-0151 (telephone), 303-778-0748 (facsimile)